

### **III. REMARKS**

1. Claims 1, 4, 13, 14, 16, 17 and 18 are amended. Claims 19-22 are new.

Claim 4 is amended to overcome the Examiner's objection.

The amendment to claim 17 is to correct the antecedent basis of the "user" and the "palm".

The amendment to claim 18 is amended only to correct a typographical error and not for patentability reasons.

Applicant appreciates the indication of allowable subject matter in claims 2, 5, 9, 17 and 18.

2. Claims 1, 4, 6, 8, 11-13 and 16 are patentable under 35 U.S.C. 103(a) over Suso et al., U.S. Patent No. 6,069,648 ("Suso"), in view of Yoshida et al., U.S. Patent No. 6,690,417 ("Yoshida"). Claim 1 recites a third housing part arranged for holding the device on the palm in the first and second use positions and comprising a first wall to be placed transversely to the user's palm, an opposite wall on the opposite side of the third housing part in relation to the first wall, two adjacent walls between the first wall and the opposite wall, and an upper wall. The combination of Suso and Yoshida does not disclose or suggest at least this feature.

Suso discloses a communication terminal device including an upper case (1), a lower case (2), a connection part (3), display/operation parts (4, 5), a rotary shaft supporting part (6), a rotary shaft (7), a housing member (8), a camera lens (9), an antenna (10), a power source button (11), an earphone jack (12) and a microphone (13) (Col. 2, L. 49-58). The display/operation parts (4, 5) are rotatably mounted so as to rotate around the housing member (8) and are opposed to each other when opened and piled to each other when closed (Col. 2, L. 59-65). The hinge is constructed by the rotary shaft (7) provided for the upper case (1) and the rotary shaft supporting part (6)

provided for the lower case (2), so that the upper case (1) and the lower case (2) can be opened and closed like a notebook (Col. 2, L. 66 – Col. 3, L. 3). The housing member (8) is rotatably attached to the rotary shaft supporting part (6) from the opposite side of rotary shaft (7). A thin video camera is housed in the housing member (8) and a hole is opened in a part of the housing member (8) and the camera lens (9) is attached to the hole part. There are no parts projecting from the housing member (8) to the outside. (Col. 3, L. 3-11). The power source button (11) is provided at the top of the rotary shaft (7) (Col. 3, L. 23-26). Nowhere is a third housing part, as claimed by Applicant, disclosed or suggested in Suso.

The Examiner equates the housing (8) of Suso with the “third housing part” claimed by Applicant and refers to column 2, line 54 through column 3, line 5 and to column 4, lines 11-60. Nowhere in these cited passages does Suso disclose that the housing (8) is “arranged for holding the device on the palm in the first and second use positions”. Rather, the housing member (8) includes a camera lens (9) where the housing (8) and the lens (9) can be rotated (See Figs. 5b and 5d). Holding the housing (8) in a user’s palm would render the camera and lens (9) useless as a user would not be able to orient the lens as disclosed in Suso. Holding the device of Suso only by the housing (8) would leave the upper case (1) and lower case (2) unsupported so that they rotate about the housing (8) in an uncontrolled manner.

The third housing part claimed by the Applicant includes a first wall to be placed transversely to the user’s palm, an opposite wall on the opposite side of the third housing part in relation to the first wall, two adjacent walls between the first wall and the opposite wall, and an upper wall. The housing (8) of Suso is cylindrical, therefore the housing (8) does not have “a first wall to be placed transversely to the user’s palm”. Because the housing (8) is cylindrical it does not have “an opposite wall on the opposite side ... in relation to the first wall”. There is nothing in Suso that divides the cylindrical surface of the housing (8) into sections corresponding to the walls claimed by Applicant. In fact, Suso states that “There are no parts projecting from the housing member (8) to

the outside" (Col. 3, L. 10-11). For these same reasons, the housing (8) does not have an upper wall.

Because the housing (8) of Suso is cylindrical and does not have a "first wall" or an "opposite wall" the hinge of Suso is not on the opposite wall as recited in claim 1. Claim 1 recites that the hinge mechanism is fitted on the opposite wall and arranged for folding the first and the second housing parts in relation to the third housing part. The hinge in Suso is constructed by the rotary shaft (7) provided for the upper case (1) and the rotary shaft supporting part (6) provided for the lower case (2) (Col. 2, L. 66 – Col. 3, L. 3). As can be clearly seen in Figures 1a-1c in Suso, the hinge (6, 7) is on the left side of the housing (8). This is not what is claimed by Applicant.

Furthermore, it is noted that the Examiner refers to the left side of the housing (8) as being both the "opposite wall" and the "adjacent wall" in making the rejection of claim 1. Also in making the rejection, the examiner refers to "one of said adjacent walls is provided with at least one key button" which is an incorrect statement. (Office Action dated 4/21/06, p. 5, lines 9-15). Claim 1 recites that each one of the two adjacent walls is provided with at least one key button within the reach of the fingers for controlling the electronic functions of the device. This is not disclosed by Suso. In Suso, the power source button (11) is provided at the top of the rotary shaft (7) (Col. 3, L. 23-26) not on the housing (8). The housing member (8) of Suso is not suitable for holding the device and thus, the location of "key buttons" have not been fitted on the housing (8) as clearly shown in Figures 7-9.

Moreover, claim 1 recites that the first wall, the upper wall or an edge between the first wall and the upper wall is provided with a navigation key for browsing menus displayed on the electronic display. These features are simply not disclosed or suggested by Suso. The Examiner refers to this feature being the power source button (11) but for the reasons described above the power source button (11) is not the same as the "navigation key" claimed by Applicant.

Combining Yoshida with Suso does not remedy the above noted deficiencies. Yoshida discloses a digital camera (100) having on its main body, a speaker (105), a display (104), a keyboard (103), a jog dial and a microphone (106) (Col. 5, L. 24-35). The portion where the speaker (105) is provided is arranged in such a manner that is freely opened (moved out from) or closed (moved up to the digital camera (100) main body) in the direction indicated by arrow B (Col. 5, L. 42-48; Fig. 2). Yoshida simply does not disclose or suggest a "third housing part" as recited in claim 1.

Therefore, claim 1 is patentable over the combination of Suso and Yoshida. Claims 13 and 16 are patentable over the combination of Suso and Yoshida for reasons similar to those described above with respect to claim 1. Claims 2-12, 14, 15 and 19-22 depend from claims 1, 13 and 16 and are patentable at least by reason of their respective dependencies.

Further, it is respectfully submitted that there is no legal motivation to combine Suso with Yoshida. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (See M.P.E.P. § 2142). As noted above, the combination of Suso and Yoshida does not disclose or suggest each feature of Applicant's claim 1. Thus, a *prima facie* case of obviousness cannot be established.

Neither Suso nor Yoshida provide any suggestion or motivation to be combined or modified as proposed by the Examiner and the Examiner's proposition that Applicant's claims would be obvious as recited is not supported by the factual contents of Suso and Yoshida. Motivation for purposes of 35 U.S.C. 103(a) requires that the reference itself

and/or the knowledge generally available to one of skill in the art provide the requisite motivation or suggestion to modify the reference. As described above, neither Suso nor Yoshida disclose or suggest a "third housing part". Moreover, if the device of Suso was modified with the buttons (103) of Yoshida, the buttons (103) would be placed on the upper case (1) of Suso so that the device of Suso could be used in the closed position. Because of the nature of Suso's device (i.e. the upper and lower cases (1, 2) rotating around the housing (8)), the buttons (103) of Yoshida would not be placed on the housing (8).

When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 25 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Suso and Yoshida under 35 U.S.C. 103(a) is not established.

Claim 4 recites an electronic display arranged on at least one of the two adjacent walls, and wherein the electronic display is arranged for presenting data and information to the user in the closed use position of the device. Yoshida discloses an electronic display (104) to be used in the closed use position of the device. If Suso and Yoshida were combined the electronic display would be placed on the back side of the upper case (1) or the lower case (2) in Suso and not in the cylindrical housing member (8). Thus, claim 4 is patentable.

Claim 8 recites that one of the housing parts is provided with electronic image sensor means for still and/or video images, wherein said at least one button and the navigation key are also arranged for the control of said electronic image sensor means. The Examiner argues that the power source button (11) and the rotary shaft (7) of Suso (Fig. 2) encompass a navigation key. This statement is incorrect. In Suso, the rotary shaft (7) is fixed to the upper case (1) and is used to construct a hinge via the rotary

shaft support (6) of the lower case (2) (Col. 2, L. 66 – Col. 3, L. 3). There is no absolutely no disclosure or suggestion in Suso of the rotary shaft (7) being used to rotate or control the camera lens (9). To rotate to camera lens (9), a user of the device in Suso must grip and rotate the housing member (8). In addition, the power source button (11) merely turns the device on and off and is not disclosed as navigating anything. The various modes of the device in Suso are selected using the cursor button (15), which is a type of soft key (e.g. it is not a physical key but rather is displayed on a touch enabled screen for selection by a user). Therefore, claim 8 is patentable.

Claim 12 recites that the device is a communication device comprising at least a CMT user interface which is available in the closed use position of the device, and at least a PDA user interface which is available in the opened use position of the device. Suso simply does not disclose a CMT user interface that is usable in the closed use position of the device as claimed by Applicant. The microphone (13) is placed in the inner wall of the lower case (2) so that the device must be opened when making a call (Col. 3, L. 19-26; Figs. 1a-1c). In Suso, the CMT and PDA user interfaces are both used in the opened use position. This is not the same as what is being claimed by Applicant. Yoshida discloses an electronic display (104) to be used when the LCD (107) is in a closed position. In Yoshida, the display (104) is located on the main body of the digital camera (100). Thus claim 12 is patentable.

3. Claims 14 and 15 are patentable under 35 U.S.C. 103(a) over Suso and Yoshida in further view of Abe, JP Publication 11-136655. As described above, the combination of Suso and Yoshida fails to disclose or suggest the features of Applicant's claim 13. Combining Abe with Suso and Yoshida do not remedy these deficiencies.

Abe discloses an information communication equipment adapter (30) for a portable telephone set. The adapter (30) is provided with a jack connecting to a circuit that sends/receives a transmission reception signal with a telephone set (10), and an adapter use handset (60) is formed by connecting a microphone (63) to a headphone having speaker sections (61R, 61L), and the handset (60) connects electrically to the

jack (37) of the adapter (30) through a cable (65). The adapter (30) is separate from the phone (10) and the hinge on the phone is not connected in any way to the adapter (30). Thus, the combination of Suso, Yoshida and Abe do not disclose all the features of claim 13. Claims 14 and 15 are patentable at least by reason of their respective dependencies.

4. Claim 3 is patentable under 35 U.S.C. 103(a) over Suso and Yoshida in further view of Frye et al., U.S. Patent No. 6,188,765 ("Frye"). As described above, the combination of Suso and Yoshida fail to disclose all the features of Applicant's claim 1. Combining Frye with Suso and Yoshida fails to remedy these deficiencies. Frye discloses a folding portable radiotelephone designed to be opened from a closed position using only one hand. Thus, claim 1 is patentable over the combination of Suso, Yoshida and Frye. Claim 3 is patentable at least by reason of its dependency.

5. Claim 7 is patentable under 35 U.S.C. 103(a) over Suso and Yoshida in further view of Phillipps, GB Publication 2314179A. As described above, the combination of Suso and Yoshida fail to disclose all the features of Applicant's claim 1. Combining Phillipps with Suso and Yoshida fails to remedy these deficiencies. Phillipps discloses a portable electronic apparatus has user input means (7, 8, Fig. 2) for example a keyboard or tilt switches, disposed in back-to-back relation to a display. The apparatus may be hinged such that it can be opened and closed in the manner of a book, in which case the display may be either in two parts (25, 26), that can be brought together when the apparatus is open or flexible so that it can fold on itself when the apparatus is closed. The apparatus may be a computer and/or mobile telephone. Phillipps does not disclose or suggest a "third housing part" as claimed by Applicant. Thus, claim 1 is patentable over the combination of Suso, Yoshida and Phillipps. Claim 7 is patentable at least by reason of its dependency.

6. Claim 10 is patentable under 35 U.S.C. 103(a) over Suso and Yoshida in further view of Abe and Frye. For the reasons described above, the combination of Suso and Yoshida fails to disclose or suggest the features of Applicant's claim 1. It is submitted

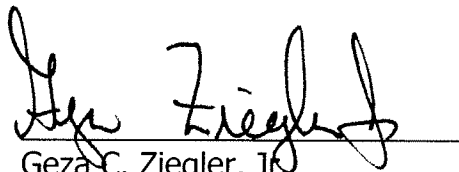
that the combination of Suso, Yoshida, Abe and Frye cannot as well. Therefore, claim 10 is patentable at least by reason of its dependency.

Furthermore, the combination of Suso, Yoshida, Abe and Frye does not disclose or suggest a hinge mechanism having an ejector mechanism and an unfolding mechanism as claimed in Applicant's claim 10.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment of \$320.00 for the additional dependent claims fee and a one-month extension of time, as well as for any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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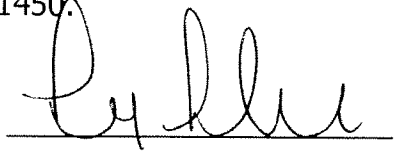


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